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09/681,298	03/14/2001	Christopher Donald Johnson	17243-00009	9617

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EXAMINER
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ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>10 January 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-29 and 31-59* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-29 and 31-59* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January

10, 2006 has been entered.

Claims 1, 13, 25, 37, 47, 56 and 59 have been amended. Claim 30 has been

previously canceled. Claims 1-29 and 31-59 are now pending in this application.

Response to Amendment

2.   Applicant's amendments to claims 1, 13, 25, 37, 47, 56 and 59 are

acknowledged.

Response to Arguments

3.   Applicant's arguments have been fully considered, but are found unpersuasive.

In the Remarks, Applicant argues that Hartnett does not teach valuating assets in a

portfolio by segmenting the portfolio assets into three valuation portions.

With regard to this argument, Examiner respectfully disagrees. Since the claims

do not expressly recite *how* a portfolio is segmented into portions, Examiner has

considered the teaching of Harnett's categorizing of assets as segmenting the portfolio

where the portfolio is simply segmented based on its asset categories (col. 60, line 9;

col. 61, lines 1, 19, 29 and 39; col. 62, line 28; Assets within a portfolio are categorized

into various categories, and thus, various portions within a portfolio. Assets are

categorized as debt, indexed debt, enterprise stock, foreign currency, cash or annuity

and price level adjusted mortgage.). Thus, Examiner respectfully submits that Hartnett

does teach valuating assets in a portfolio by segmenting the portfolio assets into three

valuation portions. Examiner further asserts that Hartnett does teach calculating values

of assets using predetermined criteria and determining a current purchase price for the

assets in col. 48, lines 13-20. Examiner additionally notes that the intended use of

Hartnett being different than the intended use of the current invention is irrelevant, as

intended use is generally not afforded patentable weight. Thus, Hartnett is applied for

its teachings of the general principles of asset valuation that have been recited in the

claims. Applicant is reminded that one cannot show nonobviousness by attacking

references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800

F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The remainder of the arguments are moot based on the updated rejections

provided below or have been addressed in the updated rejections provided below.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-29 and 31-59 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Marpe et al. (U.S. 6,671,693) and Hartnett (U.S. 6,112,188).

As per claims 1, 13 and 25, Marpe et al. discloses a method, system and

computer for collaborating on due diligence issues to affect efficient knowledge building

within due diligence teams using a computer system coupled to a data repository, said

method comprising the steps of:

accessing stored, accumulated knowledge in a repository from prior due

diligence exercises (col. 13, lines 50-61; items 1302 and 1312 in Figure 13; The system

allows users to access data from a database, where the data is knowledge accumulated

from past exercises. Users access the knowledge database via an interface called the

Navigation Chevron.);

conducting a current due diligence exercise (col. 53, lines 12-30; The system

allows users to actively conduct strategic, financial and legal due diligence.);

applying the accumulated knowledge from past due diligence exercises to the

current due diligence exercise (col. 15, lines 49-59; col. 15, line 64-col. 16, line 16;

Users use data from past projects found in the knowledge base to conduct their current

projects.); and

storing newly accumulated knowledge from the current due diligence exercise

into the data repository of accumulated knowledge (col. 15, lines 49-59; col. 17, lines 2-

15; Users can add knowledge to the knowledge database as they complete new

projects.).

Marpe also teaches an industry solution pack that contains a knowledge database of data such as key financial activities and proven practices for performing financial due diligence and underwriting (col. 51, lines 54-57; col. 52, lines 41 and 47; col. 53, line 25).

Thus, while Marpe does disclose using accumulated knowledge and proven practices for underwriting, Marpe does not disclose specific steps for underwriting. Marpe does not expressly disclose valuating assets in a portfolio individually and collectively by segmenting the portfolio of assets into three valuation portions and by underwriting each asset individually included within a first portion of the asset portfolio, grouping and underwriting a sample of assets included within a second portion of the asset portfolio, and using the computer to statistically infer a value for assets included within a third portion of the asset portfolio. Hartnett discloses valuating assets in a portfolio individually and collectively by segmenting the portfolio of assets into three valuation portions (col. 60, line 9; col. 61, lines 1, 19, 29 and 39; col. 62, line 28; Assets within a portfolio are categorized into various categories, and thus, various portions within a portfolio. Assets are categorized as debt, indexed debt, enterprise stock, foreign currency, cash or annuity and price level adjusted mortgage.) and by

underwriting each asset individually included within a first portion of the asset portfolio to calculate a value of each asset included within the first portion of the portfolio, wherein underwriting includes analyzing an asset in accordance with predetermined criteria, and determining a current purchase price for buying the asset and a confidence factor associated with an investment return for the asset based on the

analysis (col. 27, lines 25-32; col. 36, lines 55-63; col. 48, lines 13-20; col. 60, line 13;

col. 61, lines 19, 29 and 39; col. 62, lines 10-15; Assets are segmented within a portfolio

into several portions/categories based on their asset type such as stock, debt, foreign

currency, annuity, etc., and then valuated based on their grouping. Each asset is

valuated and given a purchase price. The price of an annuity asset, for example, is the

rate of return and therefore, is the confidence factor. Additionally, assets are given final

prices, which can also be considered as a confidence factor for investment return.),

grouping and underwriting a sample of assets included within a second portion of

the asset portfolio to calculate a value of each asset within the second portion of the

portfolio based on the underwritten sample assets (col. 25, lines 60-63; col. 48, lines 13-

20; Users simulate portfolio asset valuations using the privatize tool. Assets are

valuated based on their type (i.e., portion/grouping they are in).), and

using the computer to statistically infer a value for assets included within a third

portion of the asset portfolio using an iterative process including grouping the assets

included within the third portion of the portfolio into clusters based on underwriting

values and variances of the first and second portions of the portfolio (col. 30, lines 22-

65; col. 48, lines 13-20; Asset valuations are based on the asset type (i.e.,

portion/grouping the asset is in). For example, stocks are valuated differently than

annuities. Additionally, the asset valuation is performed using an iterative process,

where the assets are cycled through PASS modules which perform different levels of

valuations.).

Thus, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art for the knowledge maintained in the underwriting solution pack of

Marpe to include the specific asset valuation steps as taught by Hartnett because doing

so would provide the underwriting solution pack of Marpe with more extensive and

detailed accumulated knowledge relating to specific underwriting processes for use by

users seeking this particular type of knowledge, thereby providing users with an

enhanced and more helpful underwriting solution pack.

As per claims 2, 14 and 26, Marpe et al. discloses a method, system and

computer according to claims 1, 13 and 25, wherein said step of accessing stored,

accumulated knowledge in a repository further comprises the step of accessing a suite

of at least one of business processes, computer systems, analytical tools, financial

models, data manipulation tools, business process tools, methodologies and analytics

(col. 13, lines 18-61; col. 15, line 17; col. 16, lines 46-65; col. 17, lines 19-67; col. 40,

lines 17-20; The system provides users with a suite of tools for carrying out various

business functions.).

As per claims 3, 15 and 27, Marpe et al. discloses a method, system and

computer according to claim 1, 13 and 25, wherein said step of accessing stored,

accumulated knowledge in a repository further comprises the step of accessing a high

level map and associated descriptions of the roles and responsibilities within the due

diligence team such that team members can see who has functional responsibilities,

how the team members as individuals fit into the due diligence team and who to contact

for information (col. 43, line 55-col. 44, line 67).

As per claims 4, 16 and 28, Marpe et al. discloses a method, system and computer according to claim 1, 13 and 25, wherein said step of applying the accumulated knowledge from past due diligence exercises further comprises the step of accessing a due diligence project timeline with milestones and tasks arranged as at least one of Gantt charts, PERT charts and text such that key deliverable timing is developed at the beginning of the due diligence project with inputs from due diligence team members (col. 9, lines 35-52; col. 17, lines 33-67; col. 18, lines 12-24; col. 29, lines 45-65; Figure 8; The system allows users to create projects including project timelines, milestones and deliverables. Users also have access to past due diligence exercises via entire histories of the discussion database, from users who have already completed projects.).

As per claims 5, 17 and 29, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, further comprising the step of accessing a project feedback mechanism including graphical indicators for tracking key due diligence deliverables including at least one of types and quantities of underwriting completed, financial risk and return metric, total project budget and status of deliverables (col. 17, lines 37-60; col. 18, lines 41-47; col. 19, lines 35-47; The system tracks and reports on the progress of projects including status of milestones and deliverables.).

As per claims 6, 18 and 30, Marpe et al. discloses a method, system and computer according to claims 5, 17 and 29, wherein said step of accessing a project feedback mechanism further comprises the step of accessing a due diligence project

calendar with notable local and global dates identified (col. 19, lines 30-47; col. 43, lines 54-55; Figures 9 and 10; The system provides the user with calendaring features.).

As per claims 7, 19 and 31, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, further comprising the step of storing contact information of due diligence team members and collaborators including at least one of telephone numbers, e-mail address and postal address information (col. 42, line 20-col. 43, line 29; The system allows users to create and store contact information.).

As per claims 8, 20 and 32, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, further comprising the step of storing a due diligence project to do list and status for items on the to do list (col. 21, line 32-col. 22, line 61; col. 25, lines 15-25; The system allows users to maintain project task lists and the status related to the tasks.).

As per claims 9, 21 and 33, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of storing newly accumulated knowledge further comprises the step of creating a shared storage place for various due diligence functions to store project files and information such that team members and collaborators can access and retrieve the information (col. 2, lines 59-67; col. 9, lines 10-52; Figure 1).

As per claims 10, 22 and 34, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of storing newly accumulated knowledge further comprises the step of creating an information flow map that identifies sources and uses of information utilized to make due diligence decisions

(col. 13, line 18-col. 14, line 14; The system provides users with a hierarchy of categories to easily identify and find the appropriate knowledge topic.).

As per claims 11, 23 and 35, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of accessing stored, accumulated knowledge further comprises the step of accessing historical best practices stored within the data repository generated from past due diligence exercises (col. 9, lines 50-52; col. 47, lines 5-42; Users have access to accumulated knowledge from past due diligence exercises via entire histories of the discussion database, from users who have already completed projects and who have submitted data relating to their experiences with the projects.).

As per claims 12, 24 and 36, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of accessing stored, accumulated knowledge further comprises the step of accessing a database of relevant valuation information and facts associated with the due diligence to valuate a portfolio of assets (col. 51, line 9-col. 53, line 25; The system has industry-specific applications, including underwriting, valuation and financial due diligence functions.).

Claims 37-59 recite substantially similar limitations as claims 1-29 and 31-36 above. Therefore, claims 37-59 are rejected on the same basis as claims 1-29 and 31-36 above.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Risen, Jr. et al. (U.S. 6,018,714) discusses a method for determining a value of

  an intellectual property asset;

- Risen, Jr. et al. (U.S. 6,959,280) discusses a method for determining a value of

  an intellectual property asset; and

- Graff (U.S. 6,192,347) discusses a method for decomposing property into

  separately value components.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-

6727. The examiner can normally be reached Monday – Friday from 8:30am to

5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

C. Michelle Tarae
Patent Examiner
Art Unit 3623

March 16, 2006